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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/994,410

Filing Date: November 27, 2001

Appellant(s): JOHNSON, CAROLYNN RAE

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Jorge Tony Villabon  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 23 January 2006 appealing from the Office action mailed 27 December 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 20020174430A1	Ellis et al	11-2002
6181870	Okada et al	1-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23-26, 30-33, 35-39 and 41-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al (Us Patent Application Publication 2002/0174430).

**Regarding claims 23 and 31**, Ellis et al disclose a method and system for creating a video program list, comprising the steps of:

- presenting a menu including a first program list of recorded programs  
(Paragraph 0378 “Display screen 9616 may provide the user with the ability to move highlight window 9632 over a listing bar in recording listings 9618”);
- identifying each of the recorded programs in the menu using a title that refers to at least one of a subject matter and an artistic content of the recorded programs (Paragraph 0378 “Display screen 9616 may provide the user with the ability to move highlight window 9632 over a listing bar in recording listings 9618”);
- prompting a user to select at least one recorded program from the first program list to be included in a second program list (Paragraph 0378 “select

combine after option 9620 or combine before option 9622 for the recording identified in that listing bar”);

- creating the second program list, including the at least one identified program (Paragraph 0378 “Pressing a remote control “OK” key will then cause the recording for that particular listing to be combined with currently selected recording”);
- creating an identifier corresponding to the second program list (Paragraph 0378 “The combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, the user may be able to choose which name to use, or the user may be allowed to enter a new name for the combination”);
- including the identifier as a selectable item of the menu (Paragraph 0378 “The combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, the user may be able to choose which name to use, or the user may be allowed to enter a new name for the combination”).

**Regarding claims 24 and 32,** Ellis et al disclose a method and system of creating a video program list wherein the recorded programs are stored on multiple media (Paragraph 0205 “Recorded content icon 704 may permit users to distinguish between programs that are available for playback from a PVR and programs that will be airing in the future. Future programs may include VOD programs, PPV programs,

broadcast television programs, or other programming that is available through a source other than a PVR”).

**Regarding claim 25**, Ellis et al disclose a method of creating a video program list wherein the programs are represented on the menu by means of a program title (Fig. 62).

**Regarding claim 26**, Ellis et al disclose a method of creating a video program list comprising the steps of:

- prompting the user to select an order for the programs comprising the second list (Fig. 63, items 9680 and 9682); and
- playing back the video programs comprising the second list in the selected order (paragraph 0205 “A program listing in listing bars 702 may include recorded content icon 704 that indicates that a recording for that listing is currently available for playback”).

**Regarding claim 30**, Ellis et al disclose a system for generating a video recording and playback list, comprising the steps of:

- displaying a menu including a plurality of recorded programs (Paragraph 0378 “Display screen 9616 may provide the user with the ability to move highlight window 9632 over a listing bar in recording listings 9618”);
- identifying each of the recorded programs in the menu using a title that refers to at least one of a subject matter and an artistic content of the recorded programs (Paragraph 0378 “Display screen 9616 may provide the user with

the ability to move highlight window 9632 over a listing bar in recording listings 9618”);

- creating a list comprising user identified ones of the plurality of programs (Paragraph 0378 “Pressing a remote control “OK” key will then cause the recording for that particular listing to be combined with currently selected recording”);
- modifying the menu to include the list as a user selectable item on the menu (Paragraph 0378 “The combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, the user may be able to choose which name to use, or the user may be allowed to enter a new name for the combination”).

**Regarding claim 33**, Ellis et al disclose a system for generating a video recording and playback list wherein the device is operable to allow a user to order the indicated items and wherein the processor is further programmed to playback the programs according to the order in response to user selection of the identifier (Fig 63, items 9680 and 9682).

**Regarding claims 35 and 39**, Ellis et al disclose a system for generating a video recording and playback list wherein the processor is further programmed to allow the user to specify the identifier (Fig. 64, item 9706).

**Regarding claim 38**, Ellis et al disclose a method for generating a video recording and playback list wherein the steps are accomplished without modifying video and audio program content of the indicated programs (Paragraph 0378 “If desired,

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neither, either or both of the original recordings may be deleted when the combination is created." This clearly illustrates that the original programs remain after the combination is created).

**Regarding claims 36-37, and 41-42,** Ellis et al disclose a system for generating a video recording and playback list wherein the first and second storage media are selected from the group comprising: optical disc media, magneto disc media, digital tape media, analog tape media, and hard disc drive [HDD] (Paragraph 004 "In one known system, a PVR may use an MPEG encoder to digitize broadcast television and then store the digitized broadcast television for later retrieval on a hard disk drive" and Paragraph 0171 "Recording equipment 204 may include PVR 208, VCR 210, or any other suitable recording device").

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al as applied to claims above, and further in view of Okada et al (6,181,870).

**Regarding claims 34 and 40,** Ellis et al suggest a system for transferring a playback list to a second storage medium (paragraph 0172 "Data link 209 may be used



to transfer audio/video signals for programs between PVR 208 and VCR 210”), but do not specifically disclose doing so in response to a single user selection of the identifier.

Okada et al teach a system where a user defined chain is transferred from one medium to a second medium in response to a single user selection of the identifier (Col 93, line 62 - Col 94, line 2 “the editing multi-stage control unit 26 instructs the title reproduction control unit 23 to reproduce the VOBs in accordance with the PGC, out of the user-defined PGCs, that has been indicated by the user” and Col 93, lines 13-16 “the user-defined PGC information table that includes the new user-defined PGC generated in the PGC information table work are 21` is transferred to the RTRW management file work area”).

As suggested by Ellis et al and taught by Okada, the copying of an edited program to a second medium provides a secure copy of the finished product, and products that perform the function are well-known, widely used, and commercially available.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ellis et al in order to provide a command to transfer a play list to a second medium.

#### **(10) Response to Argument**

The Examiner acknowledges his error in not recognizing the fact that claims 27-29 had been cancelled and renumbered as claims 40-42. This was due, in part, to the Appellant’s statement in the amendment dated 9/30/05 that “All claims are unamended by this response.” It is further noted that the cancelled and renumbered claims have

identical recitations, so the essence of the rejections as stated by the Examiner in his final rejection mailed on 27 December 2005 remains valid.

**In re page 19 and claim 23**, Appellant's Representative states: "Instead of creating a second program list as taught and claimed in the Appellant's invention, in Ellis a Display screen 9616 provides a user with the ability to move a highlight window 9632 over a listing bar in recording listings 9618 and to select combine after option 9620 or combine before option 9622 for the recording identified in that listing bar. As such in Ellis, a user is permitted to move a highlight window 9632 over a particular listing (e.g., Sports Center) and to combine a recording of that particular listing with a currently selected recording by adding the recording of that particular listing before or after the currently selected recording."

The Examiner respectfully notes that the term "program list" is neither taught nor defined in the Appellant's specification. In fact, the term "compilation" is used extensively throughout the specification, and the closest reference to the term outside of the claims is in the amended title, which includes the term "playlist." Based on those facts, the Examiner has interpreted the term "program list" to encompass either a listing of programs as presented in the menu in Ellis Fig. 60, or a compiled listing of programs to be played together with a single command of the user. Therefore, the combined recordings created by Ellis's user by highlighting programs and selecting "combine before" or "combine after" (regarding the placement of the selected program at the beginning or ending of the playlist) clearly and explicitly discloses the creation of a

second program list, the first being the menu of programs shown in Ellis Fig. 60, and recited in the rejection above.

**In re pages 19 and 20 and claim 23**, Appellant's Representative states: "there is absolutely no teaching, suggestion or disclosure in Ellis for 'creating an identifier corresponding to said second program list' as taught in the Appellant's Specification and claimed by at least the Appellant's claim 23. Instead of creating an identifier corresponding to the second program list as taught and claimed in the Appellant's invention, in Ellis a combined recording may have the name of the originally selected program, the name of the program selected to be combined with it, or the user may be allowed to enter a new name for the combination. That is, in Ellis a name is chosen for the combination and not for a second program list as taught and claimed by at least the Appellant's claim 23."

Again, the Examiner respectfully notes that the term "program list" is neither taught nor defined in the Appellant's specification, so the Examiner has concluded that the Appellant's claimed "program list" and the "playlist" of Ellis are not patentably distinct. Further Ellis clearly and explicitly discloses the user's ability to select from a variety of automatic playlist naming methods, or can provide his or her own name for the list, as disclosed in paragraph 0378 and cited in the rejection above.

**In re page 20 and claim 23**, Appellant's Representative states: "there is absolutely no teaching, suggestion or disclosure in Ellis for 'including said identifier as a selectable item of said menu' as taught in the Appellant's Specification and claimed by at least the Appellant's claim 23. Instead of including the created identifier as a

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selectable item of the original menu as taught and claimed in the Appellant's invention, in Ellis neither, either or both of the original recordings may be deleted when the combination is created. That is, in Ellis, a name chosen for the combination is added to the menu and not an identifier for a second program list as taught and claimed by at least the Appellant's claim 23."

The Examiner respectfully notes that the Appellant's Representative has not shown how the playlist of Ellis and the Appellant's "program list" are patentably distinct. Since they are not patentably distinct, the "created identifier as a selectable item of the original menu" is clearly and explicitly disclosed by Ellis's "name chosen for the combination and added to the menu."

**Further in re page 20 and claim 23**, Appellant's Representative states "In this second program list a user is able to place the identified recorded programs in any order for combination and display. In contrast, in the invention of Ellis, a highlight window is moved over an existing bar to combine the highlight window either before or after the existing bar."

The Examiner does not find this limitation to be claimed in independent claim 23, although a narrower recitation does appear in dependent claim 26. Had that broad limitation been included in the independent claim 23, the Examiner could have cited Ellis Fig. 63, with its features of move up 9680 and move down 9682, which allow the user to place the elements of the playlist in any desired order, as he did in the rejection of claim 26 above. Even as dependent claim 26 recites, however, the "combine before"

and "combine after" features of Ellis Fig. 60 meet the limitations of both the independent and dependent claims.

**Further in re page 20 and claim 23**, Appellant's Representative states:

"Subsequently, if a second highlight window is chose for combination with the combination of the first highlight window and the existing bar, the only option is to combine the second highlight window before or after the existing combination. In contrast, in the invention of the Appellant, at least because of the taught and claimed second program list, a user is able to arrange any number of identified recorded programs in any order in the second program list for compilation and subsequent viewing in the arranged order."

Again, due to the Appellant's Representative's lack of showing patentably distinct differences between the claimed "second program list" and Ellis's "playlist," the Examiner cites the playlist editing features of Ellis Fig. 63 as cited above.

**In re page 21 and claim 24**, Appellant's Representative states: "Ellis also fails to teach, suggest or anticipate the Appellant's claim 23 further limited by 'wherein at least a first recorded program of said plurality of recorded programs is stored on a first storage medium and at least a second recorded program of said plurality of recorded programs is stored on a second storage medium' as recited in claim 24."

The Examiner respectfully disagrees. Ellis explicitly discloses a variety of media for storage as shown in Fig. 2A, as well as explicitly disclosing the listing of programs to be broadcast in Fig. 7. As is understood by those of skill in the art, a large percentage of programs to be broadcast are recorded on a storage medium before their assigned

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broadcast time, and these programs are not excluded from the program list functions of programs stored on the medium in Ellis's PVR.

**In re page 22 and claim 25**, Appellant's Representative states: "Ellis also fails to teach, suggest or anticipate the Appellant's claim 23 further limited by 'wherein such programs are represented on said menu by means of a program title' as recited in claim 25."

The Examiner respectfully disagrees. Ellis explicitly discloses the display of program titles in his menu figures throughout the reference, but particularly in the previously cited Fig. 60, where "I Love Lucy," known by those of skill in the art to be a program title reflective of its content, is illustrated at the top of listing 9618.

**In re page 22 and claim 26**, Appellant's Representative states: "Ellis also fails to teach, suggest or anticipate the Appellant's claim 23 further limited by 'prompting said user to select an order for the programs comprising said second list; and playing back the video programs comprising said second list in the selected order' as recited in claim 26."

The Examiner notes that Ellis not only explicitly anticipates and discloses placing programs in the user's preferred order in Fig. 60 with the "Combine After" and "Combine Before" buttons, but he also allows further relocation of the order of programs in Fig. 63 with the "Move Up" and "Move Down" buttons.

**In re page 23 and claim 30**, please see Examiner's remarks regarding claim 23 above.

**In re page 24 and claim 31**, please see Examiner's remarks regarding claims 23 and 30 above.

**In re page 25 and claim 32**, please see Examiner's remarks regarding claim 24 above.

**In re page 26 and claim 33**, Appellant's Representative states: "Ellis also fails to teach, suggest or anticipate the Appellant's claim 31 further limited by 'wherein said device is operable to allow a user to order said indicated items and wherein said processor is further programmed to playback said programs according to said order in response to user selection of said identifier' as recited in claim 33."

The Examiner notes that the term "order" can be construed to mean either sorting the items in a list to a particular sequence, or to issue a command. Since much of the Appellant's disclosure involves placing the items in the compilation in a specified sequence, the Examiner has decided that the Appellant intended that meaning in his rejection of claim 33. If that is the intended meaning of the term, Ellis explicitly discloses the ability of the user to rearrange the sequence of programs in his playlist both by the "Move Up" and "Move Down" buttons of Fig. 63, but by additional descriptive text in paragraph 0387.

However, if the intended meaning is the issuance of a command to playback the items in the compilation, Ellis also explicitly discloses the use of a command to playback the elements of the playlist in the sequence desired by the user through the selection of a playlist from a menu of playable recordings as analyzed and discussed above, and

the use of the "Play" button on the remote control shown in Fig. 3 and discussed in paragraph 0186.

**In re page 27 and claim 34**, Appellant's representative states: "Ellis also fails to teach, suggest or anticipate the Appellant's claim 31 further limited by 'wherein said processor is further programmed to automatically transfer all programs comprising said list from a first storage medium to a second storage medium in response to a single user selection of said identifier' as recited in claim 34."

Although the Appellant's Representative shows this claim as being rejected under 35 U.S.C § 102, the Examiner rejected it under 35 U.S.C § 103, in conjunction with Okada. However, on closer scrutiny of the Ellis reference, the Examiner finds that such a "single user selection of the identifier" is implicitly met by Ellis through the ability to play a playlist with the "Play" button on the remote control as analyzed and discussed above, and further through his disclosure in paragraph 0173 that "the set-top box 202 may route signals to display device 206 through recording equipment 204." Clearly, the intent of such a routing would be to copy the contents of the playlist onto another recording device.

**In re pages 27 and 28 and claim 35**, Appellant's Representative states: Ellis also fails to teach, suggest or anticipate the Appellant's claim 31 further limited by 'wherein the processor is further programmed to allow said user to specify said identifier' as recited in claim 35."

The Examiner respectfully disagrees. Ellis clearly and explicitly discloses the ability of the user to select a title for his playlist from a variety of sources, or can enter a



title of his own composition, as shown in Fig. 64, as well as in paragraph 0378, and implemented in paragraph 0285.

**In re pages 28 and 29 and claim 36**, Appellant's Representative states: "Ellis also fails to teach, suggest or anticipate the Appellant's claims 31 and 32 further limited by 'wherein said first storage medium is selected from the group comprising" optical disc media, magneto disc media, digital tape media, analog tape media, and hard disc drive (HDD)' as recited in claim 36.

The Examiner respectfully disagrees. Ellis clearly and explicitly discloses a variety of media that the programs material is stored on, including a hard disk drive in paragraph 004, and a video cassette, known to those of skill in the art to be analog or digital tape media, in paragraph 0171.

**In re pages 29 and 30 and claim 37**, please refer to Examiner's remarks regarding claim 36.

**In re pages 30 and 31 and claim 38**, Appellant's Representative states: "Ellis also fails to teach, suggest or anticipate the Appellant's claim 31 further limited by 'wherein said steps are accomplished without modifying video and audio program content of said indicated programs' as recited in claim 38."

The Examiner respectfully disagrees. Ellis clearly and explicitly shows that the user has the option of deleting the original recordings when compiling a playlist in paragraph 378.

**In re page 31 and claim 39**, please refer to Examiner's remarks regarding claim 34 above.

**In re page 32 and claim 40**, please refer to Examiner's remarks regarding claim 34 above.

**In re page 33 and claim 41**, please refer to Examiner's remarks regarding claim 36 above.

**In re page 34 and claim 42**, please refer to Examiner's remarks regarding claim 36 above.

**In re pages 35 and 36 and claim 40**, please refer to Examiner's remarks regarding claim 34 above.

**Further in re pages 35 and 36 and claim 40**, Appellant's Representative argues against Okada's user-cumbersome linking of cell ID numbers to create a user-defined chain. It is worth noting that the Examiner did not rely on Okada's method of creating the chain in his rejection, but rather used Ellis's linking of several named programs to create a playlist. The Examiner believes Okada's chain and Ellis's playlist are reasonably analogous, both showing the linking of separate segments of video programming into a seamless whole for the benefit of the user. The Examiner relied on Okada for the limitation of providing the linked elements in the specified sequence to another recording device with a single user action. However, as noted above in the Examiner's remarks regarding claim 34, Ellis implicitly discloses playing such a sequence through recording equipment, with the obvious benefit of being able to transfer that sequence to a second medium.

**Regarding pages 37-39 and claim 34**, please refer to Examiner's remarks regarding claims 34 and 40 above.

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In conclusion, the Examiner believes that the Appellant's primary disagreement with the rejection of the claims is based on whether the recited "program list" is patentably distinct from the "playlist" of Ellis. Since the term "program list" is neither defined nor taught in the Appellant's specification, the Examiner does not perceive a patentable distinction between her "program list" and Ellis's "playlist." Further, the title of the Application has been amended to include the term "playlist," which leads the Examiner to the conclusion that the two lists are identical, and the various claimed features of the Appellant's list are all disclosed, taught, or suggested by Ellis.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

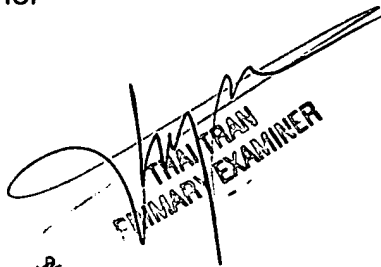
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